

REMARKS

In the Final Office Action mailed on August 17, 2010 and the Advisory Action mailed on November 2, 2010 all of pending claims 1, 3-6, 9-21 and 26-30 stand rejected.

According to the Advisory Action, the amendments proposed in the Amendment After Final dated October 11, 2010 have been entered.

The arguments presented in the Amendment After Final dated October 11, 2010 with regards to the cited references are incorporated herein by reference in their entirety. Reconsideration of the claims as presently amended in view of the following supplemental remarks and the remarks of the Amendment After Final dated October 11, 2010 is respectfully requested.

I. Claim Amendments

Independent claims 1 and 20 have been amended to broaden the recited amount of the acrylate copolymer. Support for the broadened range can be found, for example, in paragraph 33 of the published application. The narrower range recited in previous claim 1 is now recited in new claim 31.

In order to expedite prosecution, independent claim 30 has been amended to recite a beverage can having at least an end portion coated with the recited coating composition.

The claim amendments are fully supported by the application as filed and no new matter has been introduced.

II. 35 U.S.C. 102 Rejections

The Advisory Action indicated that the amendments made to claims 1 and 20 in the Amendment After Final were sufficient to overcome the rejection of claim 1, 3-6, 9-15, 18-21, 26 and 27 under 35 USC 102(b). Although the amount of acrylate copolymer recited in claims 1 and 20 has been broadened, the instant claims are similarly not anticipated.

III. 35 U.S.C. 103 Rejections

The Final Office Action at page 6, item 14, asserts that claims 1, 3-6, 9-17, 18-21, 26, 27, 29 and 30 are unpatentable over the Heyenk reference (WO 98/47974) and the Parekh reference

(U.S. 6,235,102). Applicants respectfully traverse the rejection in as much as it may be asserted to be applicable to the claims as amended.

The Final Office Action and Advisory Action continue to engage in the impermissible hindsight reconstruction of the claimed invention by impermissibly using the instant application as a roadmap to pick and choose the claimed elements from amongst the prior art.

Again, the secondary Parekh reference **teaches against** the use of from 2 to 20 weight percent (on solids) of acrylate copolymer. The Parekh reference unambiguously teaches that more than about 50% by weight (on solids) of acrylate copolymer should be used.¹ In fact, Parekh teaches that “[t]o achieve the full advantage of the present invention, the coating composition comprises about 60% to about 70% of the acrylate copolymer, by weight of nonvolatile material.”² Nowhere does Parekh teach or suggest using less than 50% by weight of acrylate copolymer. Even *arguendo* if the Heyenk and Parekh references were to be combined as proposed³, a skilled artisan would look to include more than 50% by weight of acrylate copolymer based on the explicit teachings of Parekh.

The Final Office Action nonetheless persists in asserting that a skilled artisan would have been motivated to optimize the acrylate copolymer concentration to the recited amount (and thereby ignore the explicit teachings of Parekh) in order to improve the corrosion resistance of the Heyenk composition. As stated in the heading of MPEP 2144.05(B.) “Only Result-Effective Variables Can Be Optimized.”⁴ Nothing in Parekh teaches or discloses that the acrylate copolymer of the Parekh acrylic-based topcoat is a result-effective variable for the corrosion resistance of a polyester-based coating composition such as that of Heyenk. In fact, the Parekh reference itself includes teachings that would lead a skilled artisan away from recognizing the acrylate copolymer to be such a result-effective variable. In particular, in regards to the accelerated corrosion testing data appearing at col. 16, lines 25-30, Parekh states that, “only

¹ See, e.g., col. 5, lines 52-56, col. 7, lines 50-56, and the worked Examples throughout (e.g., col. 15, lines 45-53).

² See Parekh at col. 7, lines 54-56.

³ For the reasons already of record, Applicants traverse the assertion that a skilled artisan would have been motivated to focus on or look to the Parekh reference, let alone make the proposed combination.

⁴ MPEP 2144.05(B.) states that “[a] particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation.”

minor differences in [corrosion] performance were observed by varying the ratio of acrylic copolymer to acid-terminated polyester.”⁵

Accordingly, it is respectfully submitted that all of the pending claims are allowable over the cited art.

⁵ The accelerated corrosion testing was conducted on multilayer closure coating systems having commercial epoxy-phenolic primer coats.

CONCLUSION

In view of the foregoing, Applicants respectfully submit that all of pending claims 1, 3-6, 9-15, 17-21, and 26-31 are in condition for allowance. A notice to that effect is respectfully requested. The Commissioner is authorized to charge any additional fees associated with this paper or credit any overpayment to Deposit Account No. 50-2070.

Respectfully submitted,

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Electronically filed on:
December 17, 2010

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